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VB

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/137,859	11/05/98	MARBAN	47728

HM22/0929

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EXAMINER  
LEFFERS JR, G

ART UNIT	PAPER NUMBER
1636	6

DATE MAILED:

09/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/187,669

Applicant(s)  
Marban, Eduardo

Examiner  
Gerald G. Leffers Jr.

Group Art Unit  
1636



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-31 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-31 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## DETAILED ACTION

### *Election/Restriction*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, 29-31, drawn to methods of detecting potential drug targets and predicting the effects of candidate drug compounds, classified in class 435, subclasses 6, 463.
- II. Claims 16-28, drawn to modifying the conducting properties of an ion channel to determine its capacity as a drug target or its capability to reproduce a cardiac arrhythmia phenotype in culture, classified in class 435, subclasses 375, 6, 463 .

The inventions are distinct, each from the other because of the following reasons:

The inventions of Groups I-II are biologically and functionally different and distinct from each other and thus one does not render the other obvious. The methods of Group II comprise steps which are not required for or present in the steps of the Group I: modification of a nucleic acid segment encoding an ion channel protein and detection of an altered ion current due to expression of an altered ion channel (Group II). The end results of the methods of the two Groups are different: detection of potential drug targets and prediction of the effects of candidate drug compounds against potential drug targets (Group I) and modification of the properties of an ion channel in order to determine its suitability as a drug target and to reproduce a cardiac arrhythmia phenotype (Group II). Thus, the operation, function and effects of these different

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methods are different and distinct from each other. Therefore, the inventions of these different, distinct groups are capable of supporting separate patents.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and because the non-patent literature search required for Group II is not required for Group I (e.g. ion channel proteins, cardiac arrhythmia, etc.), restriction for examination purposes as indicated is proper.

A telephone call was made to Peter Corless on 7/20/00 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

### ***Conclusion***

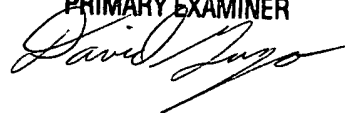
Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014. NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Leffers, Jr. whose telephone number is (703) 308-6232. The examiner can normally be reached on Monday through Friday, from about 9:00 AM to about 5:30 PM. A phone message left at this number will be responded to as soon as possible (usually no later than 24 hours after receipt by the examiner).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. George Elliott, can be reached on (703) 308-4003.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

DAVID GUZO  
PRIMARY EXAMINER  


  
G. Leffers, Jr.  
Patent Examiner  
Art Unit 1636

September 27, 2000